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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,724	11/01/2000	Mario Sandor	198956US0	1228

22850 7590 03/04/2003

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EXAMINER	
YOON, TAE H	

ART UNIT	PAPER NUMBER
1714	19

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.	Applicant(s)
09/702,724	Sandor et al
Examiner	**Group Art Unit**
T. Yoon	1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 2-12-03.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1 and 4-29 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 4, 5, 7-24 and 26-29 is/are rejected.

☒ Claim(s) 6 and 25 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 5, 7-9, 11-14, 20, 21, 23 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Guerin (US 5,643,993).

Rejection is maintained for reason of record and following.

Again, an invention in a product-by-process claim is a product, not a process. See ***In re Brown***, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and ***In re Thorpe***, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985). Since the PTO does not have equipments to conduct the test, it is fair to require applicant to shoulder the burden of proving that his polymer differ from those of Guerin. ***In re Best***, 195 USPQ 430,433 (CCPA 1977).

Applicant's declaration and argument have been considered, but found nonpersuasive since the comparison must be based on the closest prior art, the monomers used in the example of

Guerin, not on applicant's own choice. Alos, the scope of the claimed invention is broader than the actual showing even if said showing had any probative value. Applicant failed to show that the first polymer of Guerin obtained in the presence of a chain transfer agent does not have the recited molecular weight.

Claims 1, 4, 5, 7-24 and 26-29 are rejected under 35 U.S.C. 103(a) as obvious over Guerin (US 5,643,993) alone, or in view of Hieda et al (US 5,804,676).

The instant invention further recites monomer ratios of M1 and M2, weight molecular weight of the polyme phase obtained in the absence of the chain transfer agent and a process claims reciting the use of a chain transfer agent in either polymerization of M1 or M2 over Guerin.

The examples of Guerin show the use of a chain transfer agent in both polymerization of M1 and M2 as stated by applicant, however, Guerin teaches the use of a chain transfer agent in an amount up to 1 part by weight per 100 parts by weight of monomers at col. 6, lines 21-25. It is well known that said up to 1 part by weight encompasses zero part. The examiner cites ***In re Mills***, 477 F2d 649, 176 USPQ 196 (CCPA); Reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples. Guerin also teaches various amounts monomer and ratios thereof at col. 4, lines 1-15, 61 tocol. 5, line 2 and in examples. Hieda et al teach the effect of a chain transfer agent on molecular weights as pointed out in previous office action.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize a chain transfer agent in either in polymerization of core or shell in Guerin since Guerin teaches employing up to 1 wt.% of said a chain transfer agent which encompasses zero wt.%, and a polymer phase obtained without a chain transfer agent would have yield a high molecular weight as evidenced by Hieda et al.

Claims 6 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/March 3, 2003

TAE H. YOON
PRIMARY EXAMINER